

REMARKS

This response is submitted in reply to the Office Action dated September 19, 2006. Claims 1-6 and 8-38 currently stand rejected. Applicants respectfully traverse.

In light of the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §102

Claims 1-6 and 8-38 currently stand rejected under 35 U.S.C. §102(e) as being anticipated by Blumenthal (U.S. Patent Application Publication No. 2003/0069792). Claims 1-6 and 8-38 also currently stand rejected under 35 U.S.C. §102(e) as being anticipated by Sibert (U.S. Patent No. 6,928,623). Claims 1, 23 and 27 also currently stand rejected under 35 U.S.C. §102(e) as being anticipated by Laage et al. (U.S. Patent Application Publication No. 2002/0138445, hereinafter "Laage"). Applicants respectfully traverse.

Independent claim 1 recites, *inter alia*, automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party and transmitting the information entity with the automatically inserted transaction information from the user equipment. In other words, an information entity has transaction information automatically inserted in response to either receipt of an information entity associated with the transaction or a determination that the information entity was sent by a trusted party and is then sent from a user equipment. For example, a user operating a mobile terminal may have information regarding a purchase automatically inserted into a form required to affect the purchase and then send the form from the mobile terminal in order to execute the purchase. Accordingly, the information entity that is sent from the user equipment according to the claimed invention includes transaction information that was automatically inserted. However, notably the automatic insertion occurs in response to a particular stimulus, namely either receipt of an information entity associated with the transaction or a determination that the information entity was sent by a trusted party.

In the Response to Arguments section of the Office Action (pages 12-14), the Office Action presents a lengthy discussion of the disclosure of Blumenthal. However, nowhere in the explanation of Blumenthal in the Office Action nor, more importantly, in Blumenthal itself is there any teaching or suggestion related to automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party and transmitting the information entity with the automatically inserted transaction information from the user equipment as recited in independent claim 1.

In this regard, at paragraphs [0030] and [0031] of Blumenthal a digitally signed and/or encrypted confirmation of order and an electronic identity associated with a client are transmitted from a payment terminal device to a payment service equipment. There is no disclosure in the cited passage, or indeed in all of Blumenthal, of an information entity associated with the transaction which includes a data field. Furthermore, Blumenthal fails to teach or suggest the automatic insertion of transaction information into such a data field. Moreover, Blumenthal fails to teach or suggest, even if such automatic insertion occurs, that such automatic insertion occurs in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party. Finally, Blumenthal then necessarily fails to teach or suggest transmitting the information entity as claimed in independent claim 1. To the contrary, Blumenthal merely discloses that separate pieces of information (the confirmation of order and the electronic identity) are transmitted.

In response to the prior Office Action, Applicants submitted the following query “if the confirmation of order is seen as being analogous to the claimed information entity, then where does Blumenthal disclose any data fields within the confirmation of order that have transaction information automatically inserted?” Although the Office Action relates disclosure from Blumenthal, the Office Action never answers the query above, nor makes clear what features of Blumenthal meet the claimed features above.

To the contrary, Applicants note that for the above recited features of the claimed invention, the Office Action recites the language of the claimed invention and provides a comprehensive and exhaustive listing of passages from Blumenthal (which presumably disclose

the corresponding features). Separately, in the Response to Arguments section, the Office Action recites several quotations from the listing of passages from Blumenthal. However, the Office Action never correlates the disclosure of Blumenthal to the claimed invention with an explanation of the relevance of the corresponding passages. Applicants respectfully note that MPEP 707.05 states that “During the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. *When such prior art is cited, its pertinence should be explained.*” (Emphasis Added). In this regard, Applicants respectfully note that citation of a list of passages of the cited reference in connection with a claimed feature does not constitute an explanation of the pertinence of the prior art cited. Furthermore, a separate dissertation on the disclosure of the reference without application to the claims at issue would not seem to be an explanation of the pertinence of the prior art cited required in the MPEP either. Accordingly, Applicants respectfully request a more clear explanation of the pertinence of each of the passages which are purported to correspond to each claim element in order to hasten resolution of any differences between Applicants and the Examiner with regard to interpretation of the claim elements and, in any case, narrow issues for appeal, if necessary. Accordingly, Applicants respectfully request a more clear explanation of how each passage of the cited references is interpreted to teach or suggest each corresponding claimed feature in any future rejections.

Applicants also note that paragraphs [0065]-[0067] describe the confirmation of order as including information relating to the order that the client has placed, such as the date, the products and/or services ordered, the total sum owed, etc., however, the cited passage fails to describe such information as being automatically inserted into any fields of the confirmation of order. Furthermore, paragraphs [0084] and [0085] merely describe the confirmation of an order. However, these paragraphs also lack any disclosure regarding automatically inserting transaction information into a data field of an information entity. Additionally, none of the cited passages teach or suggest performance of such automatic insertion in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1. Moreover, no specific citation is given for this feature, nor is any explanation given as to what feature of Blumenthal corresponds

to this claimed feature. Accordingly, Blumenthal fails to teach or suggest automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party and transmitting the information entity with the automatically inserted transaction information from the user equipment as claimed in independent claim 1.

Sibert is directed to a method and system for selecting a target window for automatic fill-in. The Office Action asserts that Sibert discloses automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party at col. 2, lines 10-30 and col. 5, lines 1-45. Applicants respectfully disagree.

Col. 2, lines 10-30 of Sibert describes a digital wallet in which form completion may be “automatically” performed by the user by manually “dragging” information to its appropriate location. Clearly the cited passage fails to teach or suggest automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1. Col. 5, lines 1-45 describes the automatic insertion of information into appropriate locations on a merchant website in response to activation of an auto-fill button (326). Accordingly, col. 5, lines 1-45 (and in fact all of Sibert) also fails to teach or suggest automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1.

Laage is directed to a method of protecting a payment instrument in non-face-to-face transactions. Laage is asserted to disclose the above recited feature at paragraph [0084] and [0119]. However, paragraph [0084] describes an automatic form filling technique in which the user must identify fields that are used in the order form. If a match is found between the identified fields and a representative pattern, the corresponding data may be transferred from an electronic wallet to the order form. However, like Sibert, paragraph [0084] of Laage merely

describes “automatic” form filling in response to user action and not in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1. Meanwhile, although paragraph [0119] of Laage includes the term “trusted third party”, there is no relationship between determining that an information entity has been sent by a trusted third party and, in response to such a determination, automatically inserting transaction information into a data field of an information entity as recited in independent claim 1. Accordingly, Laage also fails to teach or suggest automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1.

Thus each of Blumenthal, Sibert and Laage individually fails to teach or suggest at least automatically inserting transaction information into a data field of an information entity in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party as recited in independent claim 1. Therefore, even if the cited references were to be considered in combination rather than individually, the cited references would still fail to teach or suggest the claimed invention.

It is submitted that independent claims 23 and 27 each contain recitations substantially similar those of independent claim 1 with respect to transmitting the information entity with the automatically inserted transaction information from the user equipment and that the automatic insertion is performed in response to one of receipt of an information entity associated with the transaction or determining that the information entity has been sent by a trusted party. Thus, independent claims 23 and 27 are patentable for at least the same reasons as given above for independent claim 1.

Claims 2-6, 8-22, 24-26 and 28-38 depend either directly or indirectly from corresponding ones of independent claims 1, 23 and 27, and thus include all the recitations of their corresponding independent claims. Therefore, dependent claims 2-6, 8-22, 24-26 and 28-35 are patentable for at least the same reasons as given above for independent claims 1, 23 and 27.

Appl. No.: 10/083,169
Amdt. Dated 12/19/2006
Reply to Office Action of 09/19/2006

Accordingly, for all the reasons stated above, Applicant respectfully submits that the rejections of claims 1-6 and 8-38 are overcome.

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Amdt. Dated 12/19/2006
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CONCLUSION

In view of the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

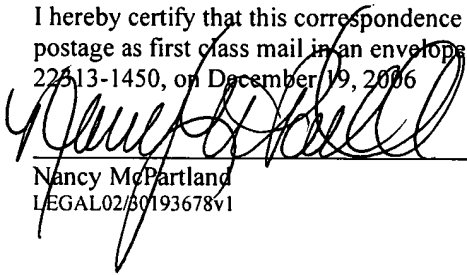


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LEGAL02/00193678v1

12-19-06
Date